

Remarks:

Claims 1-5, 10-12, 14-26, and 31-37 are pending. Applicant has amended the claims to distinctively claim the subject matter of the invention. By virtue of this amendment, claims 1-4, 10-12, 14, 15, 17, 20, 24, 26, and 33 are amended. Claims 5, 16, 25, and 34 are canceled. No new matter is added as support for the amendments is found within the Specification and the drawings. It is submitted that the application, as amended, is in condition for allowance.

Applicant is not conceding that the subject matter canceled or withdrawn by this amendment is not patentable over the art cited by the Examiner. Any subject matter canceled or withdrawn in this amendment was canceled or withdrawn solely to facilitate expeditious prosecution of the allowable subject matter noted by the Examiner. Applicant respectfully reserves the right to pursue subject matter presented prior to this amendment in the present application or in one or more continuing applications.

§103 Rejection(s):

Claims 1-4, 10-12, 14, 15, 17-24, 26, 31-33, and 35-37 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,909,705 to Lee (hereafter "Lee") in view of U.S. Patent Publication No. 2002/0046131 to Boone et al. (hereafter "Boone"). Claims 5, 16, 25, and 34 are rejected under 35 U.S.C. §103(a) as being unpatentable over Lee in view of Boone and further in view of U.S. Patent No. 6,147,986 to Orsic (hereafter "Orsic"). These rejections are respectfully traversed.

It is respectfully noted that the cited references must disclose "each and every element as set forth in the claim, either expressly or inherently" such that "[t]he identical invention must be shown in as complete detail as is contained in the ... claim" and "[t]he elements must be arranged as required by the claim." MPEP §2131.

Also, it has been long held that to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

In other words, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Further, §103 does not allow the Examiner to engage in a picking and choosing from the prior art only to the extent that it will support a holding of obviousness, while excluding parts of the prior art essential to the full appreciation of what the prior art suggests to one of ordinary skill in the art. *In re Wesslau*, 147 USPQ 391 (CCPA 1975).

Lee is directed to integrating Bluetooth networks with cellular networks, so that the two networks can inter-operate with devices enabled for both types of networks. See Abstract; column 2, lines 39-42.

Lee fails to teach or suggest all of the elements recited in claim 15, as amended. In particular, Lee fails to teach or suggest “determining whether a previously stored cellular network attribute is current; obtaining the cellular network attribute from a second device connected to the first device in the cellular, in response to determining that the previously stored cellular network attribute is not current; and terminating the

connection between the first terminal and the first device, in response to completing the forwarding of the cellular network attribute to the first terminal.”

Boone is directed to facilitating network-based commerce. A client communicates with a host (e.g., an auction facility) using a web browser to view web page content provided by the host. See paragraph [0034]. Once a URL is typed into the web browser, a DNS server translates the URL to an IP address, and the client uses the IP address to request the web page from the host. See paragraph [0035]. Upon receiving the request (i.e., inquiry), the host provides the web page content to the client.

Boone fails to cure the deficiencies of Lee as Boone fails to teach or suggest “determining whether a previously stored cellular network attribute is current; obtaining the cellular network attribute from a second device connected to the cellular network by way of the first device, in response to determining that the previously stored cellular network attribute is not current; and terminating the connection between the first terminal and the first device, in response to completing the forwarding of the cellular network attribute to the first terminal,” as recited in claim 15.

The Examiner on contends on page 4 of the Office Action that the inquiry disclosed in Boone reads over the request recited in claim 15. If such is the case, Boone directly teaches away from claim 15. because Boone teaches that the inquiry is to obtain “web page content,” while—Claim 15, ~~on the other hand~~, teaches that the request is to obtain “a cellular network attribute.” ~~The inquiry disclosed in Boone is to obtain wWeb page content is patently distinguishable from , while the request recited in claim 15 is to obtain a cellular network attribute.~~ [-- Explain why]

Since Boone teaches away from claim 15, it would be unreasonable to suggest that a person of ordinary skill in the art would be motivated to combine Boone with Lee or

any other reference to produce the claimed subject matter. Accordingly, Boone should be withdrawn for being an improper reference.

The Examiner also contends on page 4 of the Office Action that Boone teaches or suggests “terminating the connection between the first terminal and the communication device, in response to completing the forwarding of the cellular network attribute to the first terminal,” as recited in claim 15. Respectfully, the cited portions of Boone merely disclose providing the web page content to the client, which fails to teach or suggest terminating the connection between the client and the host after the providing.

Orsic is directed to defining an address for a mobile terminal host linked to a wired communications network. The method includes assigning an address to the mobile terminal host, wherein the address corresponds in part to a first network base station to which the mobile terminal host is connected. When the terminal host roams and becomes connected to a second network base station, the terminal host obtains a current IP address and at least one stationary terminal host in the network is informed of the current address assigned to the mobile terminal host. See Abstract; column 4, lines 46-49; column 5, lines 38-50.

Orsic fails to cure the deficiencies of Lee as Orsic fails to teach or suggest “obtaining the cellular network attribute from a second device connected to the first device in the cellular network, in response to determining that the previously stored cellular network attribute is not current; and terminating the connection between the first terminal and the first device, in response to completing the forwarding of the cellular network attribute to the first terminal,” as recited in claim 15.

In fact, Orsic directly teaches away from claim 15. In Orsic, the host 12 sends a connection request to the mobile T/H 18. After the host 12 receives a current IP address of the mobile T/H 18, a connection is established between the host 12 and the mobile T/H

18. See column 5, lines 37-50. In claim 15, on the other hand, the connection between the first terminal and the first device is terminated, in response to completing the forwarding of the cellular network attribute to the first terminal.

Since Orsic teaches away from claim 15, it would be unreasonable to suggest that a person of ordinary skill in the art would be motivated to combine Orsic with Lee or any other reference to produce the claimed subject matter. Accordingly, Orsic should be withdrawn for being an improper reference.

Further, while the suggestion to modify or combine references may come from the knowledge and common sense of a person of ordinary skill in the art, the fact that such knowledge may have been within the province of the ordinary artisan does not in and of itself make it so, absent clear and convincing evidence of such knowledge. *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998).

Here, the modification or combination proposed by the Examiner is not based on any clear and convincing evidence of a reason, suggestion, or motivation in the prior art that would have led one of ordinary skill in the art to combine the references. Rather, the reason, suggestion and motivation for the combination of references proposed by the Examiner simply is impermissible hindsight reconstruction given the benefit of Applicant's disclosure.

The Federal Circuit has consistently held that hindsight reconstruction does not constitute a *prima facie* case of obviousness under 35 U.S.C. §103. *In re Geiger*, 2 USPQ 2d 1276 (Fed Cir. 1987). Unfortunately, the Examiner rather than pointing to what the prior art discloses and teaches as to making the suggested modification relies on assumptions and statements without any support in the record. As such, the Examiner's statements regarding obviousness and motivation to modify are but shortcuts to a

conclusion of obviousness devoid of the required analytical approach based on what is actually disclosed in the prior art.

Reliance on impermissible hindsight to avoid express limitations in the claims and setting forth unsupported hypothetical teachings to recreate the Applicant's claimed invention cannot establish a *prima facie* case of obviousness. Since obviousness may not be established by hindsight reconstruction, Applicant invites the Examiner to point out the alleged motivation to combine with specificity,¹ or alternatively provide a reference or affidavit in support thereof, pursuant to MPEP §2144.03.²

Since no reasonable justification is provided in the Office Action as to how such modification or combination is possible and obviousness may not be established based on hindsight and conjecture, it is respectfully requested that the §103 rejections be withdrawn.

For the above reasons, none of the cited references, either alone or in combination, teach or suggest all the elements recited in claim 15. Therefore, it is respectfully submitted that claim 15 is in condition for allowance. Claims 17-23 depend on claim 15 and should be in condition for allowance by virtue of their dependence on an allowable base claim. Claims 1 and 24 substantially incorporate the elements of claim 15; therefore, claims 1 and 24 and claims 2-4, 10-12, 14, 26, 31-33, and 35-37 depending from claims 1 and 24 should also be in condition for allowance.

¹ *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

² "The rationale supporting an obviousness rejection may be based on common knowledge in the art or "well-known" prior art . . . If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position. When a rejection is based on facts within the personal knowledge of the examiner . . . the facts must be supported, when called for by the applicant, by an affidavit from the examiner."

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has expressly argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (888) 789 2266 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

Date: February 5, 2009

By: /F. Jason Far-hadian/

F. Jason Far-hadian, Esq.
Registration No. 42,523